Paper No. 18

# UNITED STATES PATENT AND TRADEMARK OFFICE

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DAVE W. GORDON

Appeal No. 2003-1349
Application No. 09/768,969

ON BRIEF

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9 to 13, 15 and 16, which are all of the claims pending in this application.

We AFFIRM, however, for reasons explained infra, we have denominated our affirmance a new ground of rejection under 37 CFR § 1.196(b).

## BACKGROUND

The appellant's invention relates to a thermal foot cover that can be worn over a shoe-encased or a boot-encased foot, or can be worn in place of a shoe or a boot to protect the wearer's foot from the effects of cold temperature (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. A copy of claim 9, the only independent claim on appeal, is reproduced in the opinion section below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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| Terry | 4,023,281 | May 17, 1977 |
| Oatman | 4,658,515 | Apr. 21, 1987 |
| Latzke | 4,887,368 | Dec. 19, 1989 |
| Bulzomi | 5,220,791 | June 22, 1993 |

Claims 9 to 13 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bulzomi in view of Oatman or Latzke.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Bulzomi in view of Oatman or Latzke as applied to claims 9 to 13 and 15 above, and further in view of Terry.

Claims 9 to 13 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Latzke in view Bulzomi.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Latzke in view Bulzomi as applied to claims 9 to 13 and 15 above, and further in view of Terry.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 14, mailed November 8, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 13, filed October 15, 2002) and reply brief (Paper No. 15, filed January 17, 2003) for the appellant's arguments thereagainst.

## OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

**The obviousness rejection based on Bulzomi in view of Oatman or Latzke**

*Claim 9*

We sustain the rejection of claim 9 under 35 U.S.C. § 103 as being unpatentable over Bulzomi in view of Oatman or Latzke.

Claim 9 reads as follows:

> A thermal foot cover for receiving a wearer's shoe-encased or boot-encased foot or a wearer's foot comprising an upper cover portion having an ankle opening therethrough and a bottom panel attached to said upper cover portion to define a cavity for receiving the wearer's shoe-encased or boot-encased foot or wearer's foot, at least a portion of said upper cover portion having an outer covering, an inner covering and a radiant barrier sandwiched between said outer covering and said inner covering, said radiant barrier being adapted to reflect heat inwardly into said cavity.

Bulzomi's invention relates to a heat resistant work shoe, enabling the wearer to tolerate working on hot asphalt and other heated working surfaces. Bulzomi teaches that prior art work shoes present a disadvantage since the soles become hot on hot surfaces and they may even be unbearable to wear, especially in the case of working on hot asphalt materials which may reach 350 degrees F., with the consequent inconvenience and even a risk of burn blisters if the work shoes are exposed to hot asphalt for any considerable period of time. Bulzomi further teaches that U.S. Pat. No. 4,249,319 to Yoshida; U.S. Pat. No. 4,658,515 to Oatman; and U.S. Pat. No. 4,777,740 to Akagi describe shoes or boots designed to insulate and retain heat within the shoe or

boot during cold environmental conditions. Specifically, Yoshida employs the introduction of exothermic heat inserts, Oatman uses a chamber with insulated particles and heat reflective foil to reflect heat back to the foot of the wearer and Akagi uses closely stitched foam layers to retain heat in cold weather conditions.

Figures 1-3 of Bulzomi show a heat vented work shoe with two upper external portions constructed of leather, defining a cavity therebetween, a midsole insert and tubes that permit air circulation within and out of the sole. As shown in Figures 1 and 2, the shoe includes a conventional upper work shoe body (1), designed to accommodate the foot of the wearer. The upper body (1), insulated on the interior with spongy material (18), fits comfortably around the foot of the wearer, with a snugly fitting collar (2). The upper shoe body has both an outer leather surface (16), constructed preferably of 4 oz. thick leather, and an inner leather surface (17), made preferably of 2 oz. thick leather. The outer leather surface (16) has two rows of ventilation holes (3) at the top of the shoe, beneath the collar (2). Foam insulation and man-made lining or leather cover most of the inside of the shoe (18, 19), insulating the wearer's foot and providing cushioned comfort. Attached to the upper body in a conventional manner is the sole (15). The outsole portion is made out of standard neoprene, or an oil resistant rubber, and has treading on the bottom surface for gripping the ground.

The upper work shoe body (1) of Bulzomi includes reflective material (6), such as perforated aluminum foil, placed between the outer (16) and inner (17) leather surfaces. Bulzomi teaches that this reflective material (6) reflects radiant heat away form the wearer's foot and that such heat develops from the air flowing from the sole, as well as from the exterior asphalt bed and tar material that may adhere to the sides of the shoe. Reflective material (6) has a concavity, wherein it adapts itself to the curvature of the upper part of the shoe upper in which it is placed. Thus, Bulzomi teaches that his heat vented work shoe provides significantly lower inside shoe temperatures for the wearer, while walking over intensely hot asphalt or tar or other road material.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Bulzomi and claim 9, it is our opinion that there is no difference. The appellant argues that Bulzomi lacks the claimed radiant barrier[1] and that the teachings of either Oatman or Latzke would not have made it

[1] A radiant barrier sandwiched between the outer covering and the inner covering, the radiant barrier being adapted to reflect heat inwardly into the cavity.

obvious at the time the invention was made to a person of ordinary skill in the art to have modified Bulzomi to include the claimed radiant barrier. We do not agree that Bulzomi lacks the claimed radiant barrier. Claim 9 is readable on Bulzomi as follows: A thermal foot cover for receiving a wearer's shoe-encased or boot-encased foot or a wearer's foot (Bulzomi's work shoe which receives a wearer's foot) comprising an upper cover portion having an ankle opening therethrough (Bulzomi's upper body (1) has an ankle opening therein as shown in Figure 1) and a bottom panel attached to said upper cover portion to define a cavity for receiving the wearer's shoe-encased or boot-encased foot or wearer's foot (Bulzomi's sole (15) is attached to the upper body (1) to define a cavity for receiving a wearer's foot), at least a portion of said upper cover portion having an outer covering (Bulzomi's upper body (1) has an outer leather surface (16)), an inner covering (Bulzomi's upper body (1) has an inner leather surface (17)) and a radiant barrier sandwiched between said outer covering and said inner covering (Bulzomi's upper body (1) has a reflective material (6), such as perforated aluminum foil, placed between the outer (16) and inner (17) leather surfaces), said radiant barrier being adapted to reflect heat inwardly into said cavity (Bulzomi's reflective material (6), such as perforated aluminum foil, inherently reflects internally generated heat inwardly into the cavity as well as reflecting externally generated heat outwardly away form the wearer's foot).

Our above determination that Bulzomi's reflective material (6), such as perforated aluminum foil, inherently reflects internally generated heat inwardly into the cavity as well as reflecting externally generated heat outwardly away form the wearer's foot is based on (1) the known reflective properties of aluminum foil; (2) Oatman's teaching that a thin film of aluminum is used as a heat reflecting material in a heat insulting insert for footwear; and (3) the appellant's teaching (page 8 of the specification) that the radiant barrier can be made from a variety of materials such as metal foil, metallized textiles or metallized flexible polymeric material.[2]

As noted above, Bulzomi does teach all the limitations of claim 9. While this is, in effect, a holding that claim 9 is anticipated by Bulzomi under 35 U.S.C. § 102(b), affirmance of the 35 U.S.C. § 103 rejection is appropriate, since it is well settled that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re

[2] While the appellant discloses that the preferred radiant barrier comprises two thin sheets of aluminum foil, extruded polymer and a reinforcing scrim, the claimed radiant barrier is not limited to this preferred embodiment. It is axiomatic that, in proceedings before the USPTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Inasmuch as the basic thrust of our affirmance of the 35 U.S.C. § 103 rejection of claim 9 differs from the rationale advanced by the examiner for the rejection, we hereby designate the affirmance to be a new ground of rejection pursuant to 37 CFR § 1.196(b) to allow the appellant a fair opportunity to react thereto (see In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

For the reasons set forth above, the decision of the examiner to reject claim 9 under 35 U.S.C. § 103 as being unpatentable over Bulzomi in view of Oatman or Latzke is affirmed, with the affirmance constituting a new ground of rejection under 37 CFR § 1.196(b).

*Claims 10 to 13 and 15*

The appellant has grouped claims 9 to 13 and 15 as standing or falling together.[3] Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 10 to 13 and 15 fall with claim 9. Thus, it follows that the decision of the examiner to reject claims 10 to 13 and 15 under 35 U.S.C. § 103 as being unpatentable over Bulzomi in view of Oatman or

[3] See page 3 of the appellant's brief.

Latzke is also affirmed, with the affirmance constituting a new ground of rejection under 37 CFR § 1.196(b).

**The obviousness rejection based on Bulzomi in view of Terry and Oatman or Latzke**

Claim 16 which depends from claim 12 has not been separately argued by appellant as required in 37 CFR § 1.192(c)(7) and (8)(iv). Accordingly, we have determined that this claim must be treated as falling with its parent claim. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Thus, it follows that the decision of the examiner to reject claim 16 under 35 U.S.C. § 103 as being unpatentable over Bulzomi in view of Oatman or Latzke as applied to claims 9 to 13 and 15 above, and further in view of Terry is also affirmed, with the affirmance constituting a new ground of rejection under 37 CFR § 1.196(b).

**The obviousness rejection based on Latzke in view of Bulzomi**

We will not sustain the rejection of claims 9 to 13 and 15 under 35 U.S.C. § 103 as being unpatentable over Latzke in view Bulzomi.

In this rejection, the examiner (answer, pages 3-4) (1) ascertained that Latzke teaches the claimed invention except for the exact formation of the element of apparel, i.e., foot cover; and (2) concluded that it would have been obvious to make a foot

covering as taught by Bulzomi with the materials of Latzke to allow the foot to be uniformly warmed.

In our view, the teachings of Bulzomi would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified Latzke to be a foot cover as set forth in claims 9 to 13 and 15. In our view, the only suggestion for modifying Latzke to arrive at the claimed invention stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 9 to 13 and 15 under 35 U.S.C. § 103 as being unpatentable over Latzke in view Bulzomi is reversed

**The obviousness rejection based on Latzke in view of Bulzomi and Terry**

We will not sustain the rejection of claim 16 under 35 U.S.C. § 103 as being unpatentable over Latzke in view Bulzomi as applied to claims 9 to 13 and 15 above, and further in view of Terry. We have reviewed the reference to Terry additionally

applied in the rejection of dependent claim 16 but find nothing therein which makes up for the deficiencies of Latzke and Bulzomi discussed above. Accordingly, the decision of the examiner to reject claim 16 under 35 U.S.C. § 103 is reversed.

## CONCLUSION

To summarize, the decision of the examiner to reject claims 9 to 13 and 15 under 35 U.S.C. § 103 as being unpatentable over Bulzomi in view of Oatman or Latzke is affirmed; the decision of the examiner to reject claim 16 under 35 U.S.C. § 103 as being unpatentable over Bulzomi in view of Oatman or Latzke as applied to claims 9 to 13 and 15 above, and further in view of Terry is affirmed; the decision of the examiner to reject claims 9 to 13 and 15 under 35 U.S.C. § 103 as being unpatentable over Latzke in view Bulzomi is reversed; and the decision of the examiner to reject claim 16 under 35 U.S.C. § 103 as being unpatentable over Latzke in view Bulzomi as applied to claims 9 to 13 and 15 above, and further in view of Terry is reversed. For reasons explained infra, we have denominated our affirmance a new ground of rejection under 37 CFR § 1.196(b).

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 1.196(b)

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| IRWIN CHARLES COHEN<br>Administrative Patent Judge | ) |
| JOHN P. McQUADE<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS<br>) AND<br>) INTERFERENCES |
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